

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) <div style="text-align: center; font-size: 1.2em;">32161</div>			
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____	Application Number <div style="text-align: center; font-size: 1.2em;">09/467,231</div>		Filed <div style="text-align: center; font-size: 1.2em;">Dec. 20, 1999</div>		
	First Named Inventor <div style="text-align: center; font-size: 1.2em;">Toshihiko Munetsugu</div>				
	Art Unit <div style="text-align: center; font-size: 1.2em;">2176</div>		Examiner <div style="text-align: center; font-size: 1.2em;">Maikhanh Nguyen</div>		
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%; border: none;"><tr><td style="width: 50%; vertical-align: top; padding-bottom: 10px;"><div style="margin-bottom: 10px;"><input type="checkbox"/> applicant/inventor.</div><div style="margin-bottom: 10px;"><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</div><div style="margin-bottom: 10px;"><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>48540</u></div><div><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</div></td><td style="width: 50%; vertical-align: top; padding-bottom: 10px; text-align: center;"><div style="margin-bottom: 10px; font-size: 1.2em;">/ Robert F. Bodi /</div><div style="margin-bottom: 10px; border-top: 1px solid black; font-size: 0.9em;">Signature</div><div style="margin-bottom: 10px; border-top: 1px solid black; font-size: 1.2em;">Robert F. Bodi</div><div style="margin-bottom: 10px; border-top: 1px solid black; font-size: 0.9em;">Typed or printed name</div><div style="margin-bottom: 10px; border-top: 1px solid black; font-size: 1.2em;">216/579-1700</div><div style="margin-bottom: 10px; border-top: 1px solid black; font-size: 0.9em;">Telephone number</div><div style="margin-bottom: 10px; border-top: 1px solid black; font-size: 1.2em;">July 12, 2007</div><div style="border-top: 1px solid black; font-size: 0.9em;">Date</div></td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<div style="margin-bottom: 10px;"><input type="checkbox"/> applicant/inventor.</div> <div style="margin-bottom: 10px;"><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</div> <div style="margin-bottom: 10px;"><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>48540</u></div> <div><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</div>	<div style="margin-bottom: 10px; font-size: 1.2em;">/ Robert F. Bodi /</div> <div style="margin-bottom: 10px; border-top: 1px solid black; font-size: 0.9em;">Signature</div> <div style="margin-bottom: 10px; border-top: 1px solid black; font-size: 1.2em;">Robert F. Bodi</div> <div style="margin-bottom: 10px; border-top: 1px solid black; font-size: 0.9em;">Typed or printed name</div> <div style="margin-bottom: 10px; border-top: 1px solid black; font-size: 1.2em;">216/579-1700</div> <div style="margin-bottom: 10px; border-top: 1px solid black; font-size: 0.9em;">Telephone number</div> <div style="margin-bottom: 10px; border-top: 1px solid black; font-size: 1.2em;">July 12, 2007</div> <div style="border-top: 1px solid black; font-size: 0.9em;">Date</div>
<div style="margin-bottom: 10px;"><input type="checkbox"/> applicant/inventor.</div> <div style="margin-bottom: 10px;"><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</div> <div style="margin-bottom: 10px;"><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>48540</u></div> <div><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</div>	<div style="margin-bottom: 10px; font-size: 1.2em;">/ Robert F. Bodi /</div> <div style="margin-bottom: 10px; border-top: 1px solid black; font-size: 0.9em;">Signature</div> <div style="margin-bottom: 10px; border-top: 1px solid black; font-size: 1.2em;">Robert F. Bodi</div> <div style="margin-bottom: 10px; border-top: 1px solid black; font-size: 0.9em;">Typed or printed name</div> <div style="margin-bottom: 10px; border-top: 1px solid black; font-size: 1.2em;">216/579-1700</div> <div style="margin-bottom: 10px; border-top: 1px solid black; font-size: 0.9em;">Telephone number</div> <div style="margin-bottom: 10px; border-top: 1px solid black; font-size: 1.2em;">July 12, 2007</div> <div style="border-top: 1px solid black; font-size: 0.9em;">Date</div>				
<div style="border: 1px solid black; padding: 5px;"><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</div>					

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Toshihiko Munetsugu
Appln. No. : 09/467,231
Filed : December 20, 1999
Title : DATA PROCESSING DEVICE AND METHOD FOR SELECTING
MEDIA SEGMENTS ON THE BASIS OF A SCORE

Conf. No. : 2093
TC/A.U. : 2176
Examiner : Maikhanh Nguyen

Customer No. : 000,116
Docket No. : 32161

PreAppeal Brief Review Arguments/Remarks

Claims 83-104 remain in this application. Claims 1-82 have been previously canceled. The examiner has acknowledged that claims 101-104 are directed to allowable subject matter should the rejections for double patenting be overcome. Applicant notes that the Notice of Appeal, and these remarks, are filed with an amendment that corrects an error in the claims that was introduced early in the prosecution of this case, namely the term “content description data” has been amended to read “context description data” as that term is used in the specification. Applicant’s representative notes that the prior filed arguments relating to “content description data” apply to the term “context description data.”

Applicant notes that a related case has been appealed (serial number 10/733,981) and is currently under review by this Examiner. In that case, the claims have been similarly rejected using the same prior art.

In the Office action of May 15, 2007, claims 83-84, 86-93, and 95-100 were rejected under 35 U.S.C. §103(a) as being unpatentable over Smith *et al.* (Video Skimming and Characterization through the Combination of Image and Language Understanding Techniques). Claims 85 and 94 were rejected as above in further view of Yeo *et al.* (U.S. 5,821,945).

As in the above referenced related case, applicant would first like to point out that it is clear that the Examiner is confusing the claimed “*context description data*” with media content (such as the video of Smith), and that her arguments all apply to the media content itself, not to any context description data that the claims clearly define as being different than media content

and which the references do not in any way teach or suggest. Thus, the Examiner's arguments do not apply to the claims. The Examiner has not pointed to any teaching that is in any way similar to the context description data of the invention.

For example, claim 83 recites a data processing apparatus including an "input unit operable to input *context description data* including a plurality of segments each for *describing* one of said plurality of scenes of *media content*". Claim 92 recites a data processing method including the step of "inputting context description data including a plurality of segments each for describing one of said plurality of scenes of media content". As discussed in detail in the response and at the previously conducted personal interviews, the prior art does not teach any such context description data or any apparatus or step for inputting such context description data.

As discussed in the response in the latest case, the Smith reference is directed toward a research project where many of the steps are done manually, perhaps using various support machines such as computers and/or various video equipment. However, Smith does not teach any context description data, and Smith fails to teach any specific data processing *apparatus* for inputting *context description data*, as those are defined by the claims. A teaching of an apparatus that might, or might not (the reference is does not discuss this matter) input media content is not relevant. As pointed out to the examiners at the personal interview, Smith is basically a *research* paper that discusses a supposedly new *method* of skimming video while preserving the important information found in the video (see abstract), so that a viewer can view time-compressed video but still capture the most important aspects of that video. See, e.g., the Abstract. Smith describes an *algorithm* to create skim videos (id. See also the Conclusion). However, all Smith discusses is the video itself, as it is silent to any data for describing the video. Thus, Smith does not teach any data processing *apparatus* for inputting *context description data*. In fact, Smith makes clear that his method relies on *manual* processes (stating that the "*manually* created skims in the initial stages of the experiment help test the potential visual clarity and comprehension of the skims" --see section 3.5, first sentence). There is no teaching of any "input unit operable to input *context description data*" as required by the claims.

In the Office action of May 15, 2007, the Examiner responds to these arguments by stating that Smith teaches "browsing" and "displaying", and thus there *must* be an apparatus for providing these functions. But that argument merely supports the existence of a display for performing those functions. Such a display could be, for example, a DVD player with a monitor,

or various functions could be provided many discrete, separate apparatuses. The teaching does not imply that there is any apparatus for inputting *context description data* that is for *describing* media content. Throughout the Examiner's arguments, she has consistently confused "context description data" with the actual media *content* data (e.g., video and/or audio). In contrast, "context description data" is "for describing one of a plurality of scenes of media content" with the context description data including a "plurality of importance attributes each...having a value representing a degree of contextual importance of [a] corresponding one of said segments". Thus, the context description data is for describing the media content, it is not the media content itself. Any reading of the specification would make this clear.

Thus, although the Examiner appears to be arguing that the ability to input *media content* is inherent to the Smith teachings (a point that is *not* conceded by applicants), such arguments are not relevant to the claim language, which specifically recites inputting *context description data*, not *media content*, and thus the Examiner's arguments cannot be applied to the claims.

Accordingly, the Examiner's arguments of the teachings of Smith regarding inputting of media content are not persuasive, as the Examiner has failed to show any teaching of inputting data that is for the purpose of *describing* media content as recited in the claims.

In addition, the Examiner admits that Smith does not specifically teach "'a value representing a degree of contextual importance'", but she states that Smith's teaching that "with prioritized video frames from each scene, we now have a suitable representation for combining the image and audio skims for the final skim" would suggest such a value, and that it would thus be "obvious" to add such a value. This is not a proper prima facie showing of obviousness. The Examiner fails to show how one skilled in the art would take the Smith teaching, and from that, obtain the claimed feature. Instead, no such suggestion exists. A teaching of merely prioritizing video frames would not suggest to one skilled in the art providing a value "representing a degree of contextual importance". Merely providing a "priority" does not imply or suggest providing a "degree of contextual importance", first because there is no teaching that the "priority" is based on any contextual importance, and second because there is no teaching that such priorities have a "degree". Accordingly, the rejection is improper.

Furthermore, there is no need for Smith to assign a "value" to determine a high or low priority, and Smith fails to explicitly teach any such value. For example, Smith could make a list of all high-priority portions of video, and thus assume that any not-listed portions are low

priority. Thus, it is not at all inherent that Smith must utilize priority “values”, and thus the Examiner’s argument fails on this point as well, as Smith does not imply any values by its prioritization scheme. At most, Smith teaches using the media content itself for the skimming (i.e., basically condensing the data into a smaller amount for quick viewing). There is no teaching of any *context description data* that *describes* media content.

Similarly, claim 83 recites “an output unit operable to output at least one of said segments based on at least one of said importance attributes”. The cited prior art fails to teach any such “output unit”. The Examiner cites various sections, none of which discuss any output unit. Merely teaching a manual process that may, or may not, use various equipment is not sufficient to show an apparatus having an output unit with the claimed features.

Claim 92, which is directed to a method that also recites “context description data” in a manner similar to claim 83, is also patentable over Smith because the reference does not teach such “context description data” as recited in the claim. Yeo fails to overcome the Smith shortcomings, and thus claims 83 and 92 are patentable over the combination of references as well. The remaining rejected claims, which depend, directly or indirectly upon one of claims 83 and 92, are patentable over the references for at least the same reasons as the parent claims.

Finally, as also discussed in the related case, the Examiner has rejected the claims for obviousness-type double patenting in light of patent number 7,134,074 (serial number 09/785,063) and application serial number 10/733,981. It should be noted that the ‘074 patent is a CIP of this application.

The Examiner has not provided a proper rejection for obviousness-type double patenting in light of the ‘981 application or the ‘074 patent. MPEP §804(II)(B)(1), second paragraph, as argued in the prior filed response. The Examiner is required to make the following factual inquiries required by MPEP §804(II)(B)(1), paragraphs 3-7:

- (A) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue;
 - (B) Determine the differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue;
 - (C) Determine the level of ordinary skill in the pertinent art; and
 - (D) Evaluate any objective indicia of nonobviousness.
- The conclusion of obviousness-type double patenting is made in light of these factual determinations.

The rejection is also required to make clear the following (MPEP §804(II)(B)(1) 8th paragraph):

(A) The differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

It was pointed out that the Examiner has failed to make the proper factual inquiries and has failed to show the differences between the inventions defined by the conflicting claims or identify any reasons why one skilled in the art would find such differences to be obvious. In fact, the Examiner has cited no art as teaching the various elements that she has indicated are “obvious” in the action of December 19, 2007, and thus she has provided no facts at all to support her rejections for double patenting. Instead, the Examiner has merely made a blanket conclusory statement that the differences between the claims would be “obvious” to one of ordinary skill. In her response to these arguments, the Examiner again makes a conclusory argument that the differences between the claims would be “obvious” to one of skill in the art. But such a conclusory statement, without providing evidence that such differences between the claims were known in the art, does not meet the requirements of the MPEP. The Examiner must show that the differences between the claims were actually known in the art (e.g., cite references), and she must show the proper motivation for adding them. Accordingly, the Examiner has not made a proper rejection for Obviousness-type double patenting. Consequently, although the Applicant asserts that the claims in the application are not obvious in light of the reference, applicant cannot respond to the rejections because applicant is not cognizant of what is considered, by the Examiner, as the obvious elements. Therefore, the Examiner must either withdraw the rejections, or provide the required factual inquiries and analysis in support of the rejection.

Respectfully submitted,

PEARNE & GORDON, LLP

July 12, 2007

By: _____ / Robert F. Bodi / _____

Robert F. Bodi, Reg. No. 48,540

1801 East Ninth Street
Suite 1200
Cleveland, Ohio 44114-3108
(216) 579-1700